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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,259	12/05/2003	Diane C. Thornton	190250-1780	1176

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EXAMINER

GEBRESILASSIE, KIBROM K

ART UNIT	PAPER NUMBER
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2128

MAIL DATE	DELIVERY MODE
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12/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/729,259

Applicant(s)

THORNTON ET AL.

Examiner

Kibrom K. Gebresilassie

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/27/07&10/5/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to amended application filed on 10/05/2007.
2. Claims 1-27 are presented for examination.

Response to Arguments

3. Response to Objection of Drawings: Applicant's arguments have been fully considered and are persuasive. Therefore, the objection is withdrawn.
4. Response to Claim Rejection-35 USC § 112(2): The rejection is overcome in view of applicant amendment to claim 19. Therefore the rejection is withdrawn.
5. Response to Claim Rejection 35 USC § 101: Applicant's arguments have been fully considered but they are not persuasive.
 - a. Claims 1-9:

Applicant's arguments regarding the 101 rejections are, *respectfully*, not understood. Applicant appears to argue the breathe of the claim and not the actual rejection. Regardless, as Applicants are aware, a claim broad enough to read on a nonstatutory embodiment renders the claim non-statutory. Applicants are requested to provide court decisions in support of their interpretation if they still take such a position.
 - b. Claims 19-27:

Applicant's are claiming tangible , but still non-statutory because applicant's defines tangible to include "paper" which, as applicants are aware, the court have found unstatutory with respect to computer readable medium.
6. Response to Claim Rejection 35 USC § 102(e): Applicant's arguments have been fully considered but they are not persuasive.

- c. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.
- d. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.
- e. Last page argument:

CONCLUSION

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

The commentary constitutes mere boilerplate recitation, is abstract, and respectfully alleges improper examination without even knowing the particular rejection that might hypothetically be deficient. Applicants are requested to

explain specifics or otherwise remove the paragraph. Furthermore, such reply borders on non-responsive, in so far as Applicants are required to address all rejections. Applicants are reminded that they made no substantial arguments against the art rejections. Furthermore, Applicant's arguments regarding the 101 rejection contradicts standard court decisions concerning 101 issues. Future such replies may be held non-responsive.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-9 are rejected under 35 U.S.C. 101 because the receiving logic, a database, assignment logic, and completion logic are just **software per se**. Because the claimed invention of Claim 1 is a system claim, the claimed invention should have associated with **physical components** in order to be statutory.

MPEP 2106 states as follows:

*"computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed **computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32***

F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions."

9. Claims 19-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For example, the claim 19 recites a "computer readable medium".

The specification states as follows: (**page 15 lines 24-25 and page 16 lines 1-15**), the "computer readable medium" defines as follows:

execution system, apparatus, or device. The computer readable medium can be, for example but not limited to, an electronic, magnetic, optical, electromagnetic, infrared, or semiconductor system, apparatus, device, or propagation medium. More specific (See: **page 15 lines 24-25 and page 16 lines 1-15**)

In light of specification, a "computer readable medium" is covered tangible and non-tangible mediums such as *electromagnetic, infrared, and/or propagation mediums*. Therefore, a "computer readable medium" is not limited to physical articles or objects which constitute a manufacture with in the meaning of 35 USC 101 and enable any functionality of the instructions carried thereby to act as a computer component and realize their functionality. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate s of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by
Publication No. US 2004/0236620 A1 issued to Chauhan et al.

Claim 1

Chauhan discloses a drawing conversion management and assignment system

(See: [0121] lines 1-5), comprising:

receiving logic of a computer system operable to receive notification of completion of a land base drawing file that is associated with a plat corresponding to a parcel of land represented by the land base drawing file(See: [0081], [121] lines 5-10);

a database coupled to the receiving logic, operable to create a drawing conversion job record associated with the completed land base drawing file (See: [0081] lines 2-5, [0121] lines 8-16, [0122] lines 1-6), the drawing conversion job record indicating that the plat corresponding to the completed land base drawing file is tasked to be converted into a new drawing format (See: [0084]);

assignment logic coupled to the database, operable to assign the drawing conversion job record to a draftsman and to instruct the database to record the assignment (See: [0081] lines 5-17), the drawing conversion job involving creation of a new drawing file based on at least information depicted in the land base drawing file

(See: [0121] lines 5-14, [0122] lines 1-6), and prior plat of the parcel of land represented by the land base drawing file; and

completion logic of the computer system coupled to the database, operable to receive a request to close the drawing conversion job record from the draftsman, and to instruct the database to mark the drawing conversion job record as closed (See: [0125]) to indicate that the plat has been redrawn in the new drawing format (See: [0084]).

Claim 2

Chauhan discloses the system of claim 1, wherein the database is operable to store a plurality of drawing conversion job records (See: [0081] lines 13-14).

Claim 3

Chauhan discloses the system of claim 2, further comprising: reporting logic coupled to the database, operable to enable any of a plurality of users to view the drawing conversion job record (See: [0081] lines 13-16).

Claim 4

Chauhan discloses the system of claim 3, wherein the reporting logic is further operable to provide a summary report of a plurality of available drawing conversion job records, assigned drawing conversion job records, and complete drawing conversion job records (See: [0049]-[0051]).

Claim 5

Chauhan discloses the system of claim 3, wherein the reporting logic is further operable to enable any of a plurality of users to view a plurality of assigned drawing

conversion job records (**See: [0081] lines 26-29**).

Claim 6

Chauhan discloses the system of claim 3, wherein the reporting logic is further operable to enable any of a plurality of users to view a plurality of completed drawing conversion job records (**See: [0125]**).

Claim 7

Chauhan discloses the system of claim 1, wherein the land base drawing file is provided by a regional land administration center (such as *Utility Center*; **See: [0084] lines 1-4**).

Claim 8

Chauhan discloses the system of claim 7, wherein the land base drawing file is in an engineering work order format (**See: Fig. 3B and corresponding texts**).

Claim 9

Chauhan discloses the system of claim 1, wherein the drawing conversion job record includes an availability date (such as *schedule dates*; **See: [0235]**), wirecenter location information (such as *map viewing*; **See: [0098]**), a completed date (such as *jobs from beginning to completion*; **See: [0235]**), a quartile assignment (such as *...complete daily assignments*; **See: [0119]**), and a fiber units allocation (such as *facility location*; **See: [0084] lines 20-23**).

Claim 10

Chauhan discloses a method for assigning and managing drawing conversions (**See: [0121] lines 1-5**), comprising the steps of:

receiving notification that a land base drawing file is available, the land base drawing file being associated with a wirecenter (**See: [0081] lines 1-5, [121] lines 5-10**), and being a basis for redrawing a plat corresponding to the wirecenter and the land base drawing file into a new drawing format (**See: [0084]**);

creating a drawing conversion job record associated with the land base drawing file (**See: [0081] lines 2-5, [0121] lines 8-16, [0122] lines 1-6**), the drawing conversion job involving creation of a new drawing file based on at least information depicted in the land base drawing file (**See: [0081] lines 8-13, [0121] lines 5-14**) and prior plat of the wirecenter represented by the land base drawing file;

storing the drawing conversion job record in a database (**See: [0081] lines 13-14**);

assigning the drawing conversion job record to a draftsman (**See: [0081] lines 24-29**);

recording the assignment of the drawing conversion job record in the database (**See: [0081] lines 24-26**); and

closing the job upon receipt of a close request from the draftsman to indicate that the plat has been redrawn in the new drawing format, by marking the drawing conversion job record as closed in the database (**See: [0125]**).

Claim 12

Chauhan discloses the method of claim 11, further comprising providing a report comprising details for at least the plurality of drawing conversion job records in the database (**See: [0048]**).

Claim 14

Chauhan discloses the method of claim 11, further comprising providing a plurality of unassigned drawing conversion job records to a plurality of users (**See: [0049]**).

Claim 15

Chauhan discloses the method of claim 11, further comprising providing a plurality of completed drawing conversion job records to a plurality of users (**See: [0125]**).

As per claims 11, 13, and 16-27:

The limitations of claims 11, 13, and 16-27 have already been discussed in the rejection of claims 2, 4, 7-10, 12, 14, and 15. The instant claims are functionally equivalent to the above rejected claims and are therefore rejected under the same rationale.

Conclusion

12. All claims are rejected.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kibrom K. Gebresilassie whose telephone number is 571-272-8571. The examiner can normally be reached on 8:00 am - 4:30 pm Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on 571-272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KG

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